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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,378	06/01/2001	Robert R. Turvey	J-2904	2808

7590

02/24/2004

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EXAMINER

PARADISO, JOHN ROGER

ART UNIT	PAPER NUMBER
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3721

SW

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,378

Applicant(s)

TURVEY, ROBERT R.

Examiner

John R. Paradiso

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) 37-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over THIEMAN (US 5956924).
3. THIEMAN discloses a method of producing plastic bags in which a web (102) of plastic is folded and a closer tape (32, 34) is secured to the free upper ends of the folded web. The ends are folded together and the ends of the closer tape is secured to the folded web. End stops (36, 38) are formed and indicia formed thereon. The bags are then sealed and severed from each other. (See THIEMAN column2 line 34 to column 3 line 25 and Figures 1 and 6.)
4. Note that the claimed “indicia” are being read on the pattern formed on the endstops of THIEMAN, since indicia is broadly defined as “distinctive marks” (Merriam Webster Dictionary) and the patterned marks on the endstops of THIEMAN are distinctively patterned.
5. THIEMAN does not specifically disclose the indicia being made by embossing with an ultrasonic welding horn and anvil or the endstop indicia being representative of production information.

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6. Regarding claims 2-6, 14-16, 20-24, and 32-34, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an ultrasonic welding horn and anvil to emboss the indicia in the invention of THIEMAN in order to minimize heat in the apparatus, since the examiner takes Official Notice of the equivalence of ultrasonic welding and heat-sealing for their use in the package-making art and the selection of any of these known equivalents to seal and emboss the endstops in the invention of THIEMAN would be within the level of ordinary skill in the art.

7. Regarding claims 1-36, THIEMAN discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the indicia to show the claimed production line information since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

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8. Further, it is well known in the art to provide production information on packaging (and in everyday life, for instance on milk cartons and bread closures to mark the time and date of production or expiration of contents) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the indicia on the endstops of the invention of THIEMAN in the form of indicia representative of production information in order to provide the consumer with more information about the container.

Response to Arguments

9. Applicant's arguments filed 2/6/2004 have been fully considered but they are not persuasive.

10. Applicant states on pages 13-14 of his Response that "Thieman does not disclose or suggest creating indicia in an end stop, where such indicia designate at least one of a production line that produced the plastic bags and a time at which the bags were produced...

Because Thieman does not disclose or suggest the creation of such indicia in end stops, he does not even contemplate the advantages provided hereby."

However, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21

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USPQ2d 1941 (Fed. Cir. 1992). In this case, since it is well known in the art to provide production information on packaging (and in everyday life, for instance on milk cartons and bread closures to mark the time and date of production or expiration of contents), one of ordinary skill in the art would have the motivation to make the combination described in the rejection above.

Examiner also notes that a broad interpretation of the independent claims' recitation of "wherein the indicia designates at least one of a production line that produced the plastic bags and a time at which the bags were produced" could be met by, in the former case, the characteristic marks left by a specific machine on the line (gripper marks, heater marks, etc.) or in the latter case, by the temperature of the heat seals (cooler means it was made a longer time ago) or position in the final stacks of product (the bottom of the final stack could mean yesterday's production, for instance).

11. Applicant outlines on pages 14 of his Response several court decisions that give guidance on the subject of indicia: *In re Gulack*, *In re Miller*, *Ex parte Ralph B. Brick*.

Examiner indeed used the guidance of these precedents to determine that since the claimed indicia is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The Examiner reasons that if a user held the bag with their thumb obscuring the indicia, their use of the bag and the usefulness of the bag would be no different that if the indicia was visible, another indication that the claimed indicia is not functionally related to the substrate.

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Conclusion

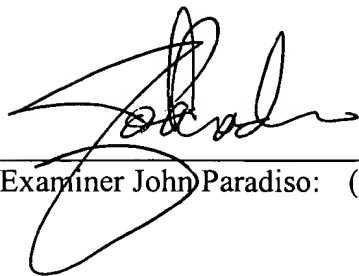
12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.



Examiner John Paradiso: (703) 308-2825



Rinaldi I. Rada
Supervisory Patent Examiner
Room 3700

February 17, 2004

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